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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------|------------------|
| 09/891,033 | 06/25/2001 | Howard H. Liebermann | 30-4698US/11872-026001 | 9448 |

7590

11/05/2003

Roger H Criss
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EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

cb/19

Office Action Summary

Application No.

09/891,033

Applicant(s)

ORLOFF ET AL.

Examiner

George P Wyszomierski

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1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/6/03 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 103(a) as obvious over Narasimhan (U.S. Patent 4,332,848).

Narasimhan discloses glassy metal strips having a composition within the limitations of instant claim 4 and which contain a repeating geometrical pattern of structurally defined protuberances and/or indentations. The preferred depth in Narasimhan is as much as 10 times the thickness of the strip; see Narasimhan column 7, line 60. This same paragraph of Narasimhan defines a structure consistent with the presently claimed "selected shape or configuration distending". With respect to claims 6-9, the examiner's position is that the suitability of a material for abrasive or cutting purposes is directly related to its composition, shape, and relative hardness to the material being abraded or cut. Because all of these parameters are the same in the prior art or the claimed invention, the examiner's position is that the claimed limitations are inherent in the Narasimhan material.

Narasimhan does not state that the prior art material is "previously cast", that it was subjected to "application of selected forces imparted by a set of stamping dies having mating surfaces", and does not specify the negative limitation of "without strip embrittlement [sic] or crystallization". These differences are not seen as resulting in a patentable distinction between the prior art and the claimed invention because:

a) The limitations regarding previously cast material and application of forces imply a difference in the process by which the claimed products are made, as opposed to any difference

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between the actual claimed products and those of Narasimhan. It is well settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, differing only in the manner by which it is made, the burden falls to applicant to show that any process steps associated therewith result in a product materially different from that disclosed in the prior art. See *In re Brown* (173 USPQ 685) and *In re Fessman* (180 USPQ 524). In the present case, Applicant has not met this burden, and the claimed products are held to be at best obvious variants of those disclosed by Narasimhan.

b) With regard to a material without strip embrittlement, no specific amount of this embrittlement is either defined or excluded by the instant claims, and whatever amount may or may not be present in the Narasimhan materials would fall within the presently claimed limitations. As to crystallization, the Narasimhan disclosure is drawn to the production of glassy or amorphous materials. It is thus a reasonable assumption that the prior art materials lack any substantial amount of crystallization.

Consequently, a prima facie case of obviousness is established between the disclosure of Narasimhan and the invention as presently claimed.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan in view of Watanabe et al. (U.S. Patent 5,622,768) or Sato et al. (U.S. Patent 4,865,664).

The Narasimhan products do not appear to contain element "Z" as defined in instant claim 5. The Watanabe and Sato et al. patents indicate that it is conventional in the art to include element "Z" in amorphous alloy strip compositions, in the amounts as defined in the instant claim. Consequently, the Watanabe or Sato disclosures would have motivated one of

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ordinary skill in the art to produce the Narasimhan products containing an amount of element "Z" as defined in the present claims.

4. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhan in view of either Watanabe et al. or Bruckner (U.S Patent 4,853,292).


The Narasimhan patent does not discuss a plurality of stacked materials or transformer cores, as required by the instant claims. Both Watanabe and Bruckner indicate it to be conventional in the art to form laminated magnetic cores by using a plurality of layers of amorphous metal alloys. These disclosures would have motivated one of ordinary skill in the art to form the materials disclosed by Narasimhan into the configurations as set forth by Watanabe or Bruckner.

5. In remarks filed with the amendment of August 27, 2003, Applicant alleges that the claimed products can be distinguished from those of Narasimhan by the presence or absence of certain geometric or magnetic properties in the inventive material compared to that of the prior art. Applicant's arguments have been carefully considered, but are not persuasive of patentability because Applicant's comments are made in general by way of argument alone, i.e. no data of probative value has been submitted showing any distinctive difference in any geometric or magnetic property of the claimed materials versus those of the prior art. Further, no such properties are recited in the instant claims.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. Effective October 1, 2003, all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW

October 31, 2003